

B' cont'd

up to 3 substituents each independently selected from the group consisting of halo, cyano, nitro, lower alkyl and lower alkyloxy.

In the Specification

Page 1, line 4, after "filed April 3, 1978" insert -- , now abandoned --.

REMARKS

Reconsideration is respectfully requested.

The requirement for restriction of Claims 1-16 on the ground of "Improper Markush" is respectfully traversed. Nevertheless, for the purpose of presenting a complete response to the Official Action, Applicants provisionally elect with traverse species Claims 2, 3, 7, 8, 12, and 13 and newly presented generic Claims 17-19.

Claims 2, 3, 7, 8, 12, and 13 are species claims to two related compounds (differing only in that L is 4-methoxy phenethyl for one and 4-hydroxyphenethyl for the other) and their corresponding compositions and methods, while Claims 17-19 are generic claims reading thereon. Since the Examiner has not indicated the distinct inventions allegedly misjoined in Claims 1, 6, 11, and 16, new generic Claims 17-19 have been drafted to reduce the scope of Claims 1, 6, and 11 for purposes of provisional election. It is noted that claims of similar scope (except as to the definition of "aryl") were allowed in Applicants' parent application SN 892,534.

A. In re Weber, et al.

The case of In re Weber, et al., 198 USPQ 328 (1978), referred to by the Examiner, has been carefully examined by Applicants' Attorney, and he respectfully concludes that this

actually allowed by the PTO long before the Markush decision, as noted by Manuel Rosa in his "Outline of Practice Relative to Markush Claims", 34 J.P.O.S. 324 (1952).

Moreover, the other decisions cited by the Examiner have also been carefully considered and are also not seen to support his position.

In re Ruzicka, 66 USPQ 226 (C.C.P.A. 1945), upheld the rejection of a Markush claim to a steroid in which a substituent was either hydrogen or HCO. That is, the Court upheld the rejection of a Markush claim encompassing two highly similar steroids on the basis that the Board of Appeals must have committed clear error before the Court will reverse it on such a highly technical chemical question. The Examiner cannot possibly contend that such a claim would ever be rejected today as being directed to an Improper Markush group.

In re Winnek, 173 USPQ 225 (C.C.P.A. 1947), related to a claim in Markush form in which the radical was selected from the group consisting of hydrogen and carboxylic acid acyl radicals. Claims to compounds in which the radical was individually hydrogen or a carboxylic acid acyl radical had been allowed, and the only question was whether the Markush claim was proper. It is again respectfully submitted that the Markush group in Winnek is clearly a proper Markush group under present practice.

Ex parte Reid, 105 USPQ 251 (Patent Office Board of Appeals 1955), followed Ruzicka and Winnek in affirming a rejection of a claim encompassing a group of isocyanates and a group of corresponding carbamyl chlorides. The issue was whether it was proper to group the isocyanates and the carbamyl chlorides in the same claim. Certainly under current chemical practice this claim would also be a proper Markush claim.

In summary, therefore, the decisions cited by the Examiner do not reflect the current state of the law and are all of such ancient vintage as to be useless for determination of the question at hand.

C. Ex parte Brouard, et al.

It is noted that the Examiner has ignored several recent decisions relating to Markush practice which support Applicants' position. The Examiner is referred particularly to the case of Ex parte Brouard, et al., 201 USPQ 538 (Board of Appeals 1976). This decision held that:

"...the fact that different fields of search are involved does not establish that the Markush group is improper."

As stated in Brouard, the compounds as a whole and their community of properties must be considered to determine whether a Markush group is proper. Since the compounds encompassed by Claim 1 are stated in the specification to have the common property of being useful as antihistaminic agents, it is respectfully submitted that the claim is proper.

D. The Manual of Patent Examining Procedure and
The Patent Cooperation Treaty

The Examiner's requirement for restriction is also inconsistent with the Patent Cooperation Treaty, in that it treats a U.S. filed application differently from one filed under the PCT. The PCT enabling legislation provides in 35 USC 372 (b) (2) that:

"the Commissioner may cause the question of unity of invention to be reexamined under Section 121 of this title, within the scope of the requirements of the treaty and the [PCT] Regulations..."

Since the compounds embraced by Claim 1 (and the compositions, methods, and intermediates embraced by Claims 6, 11, and 16, respectively) define a single general inventive concept, the requirement for restriction of these claims is improper.

The Examiner is referred to MPEP 801 through 803 for a discussion of the restriction practice in light of statute, the PCT, and recent decisions. The basis for restriction practice in MPEP 802 refers to the PCT and the general inventive concept. The cancellation of "Practice Re Markush-Type Claims" from MPEP 803 is interpreted to mean that the PTO no longer considers proper such practice as that being followed by the Examiner herein.

E. Conclusion

Finally, the Examiner himself has recognized Applicants' right to claim their invention as they choose by referring to Judge Rich's statement concerning the discretionary power of the Patent Office to require an Applicant to

"...restrict an application to one of several claimed inventions when those inventions were found to be 'independent and distinct.'" 198 USPQ 328, 332
(emphasis in the original).

This statement by Judge Rich indicates that the PTO may require an Applicant to select among claims but not to divide up a single claim.

In the present application, Applicants have claimed a class of compounds and included species compounds in Claims 1 through 5; a class of pharmaceutical compositions and included species compositions in Claims 7-10; a generic method of treatment and included species methods in Claims 12-15; and a class of chemical intermediates in Claim 16. Under Judge Rich's statement and the holding of Weber, the PTO has the power only to

require the present Applicants to elect among the inventions embodied by the following groups of claims:

Group I - Claims 1 through 5

Group II - Claims 6 through 10

Group III - Claims 11 through 15


Group IV - Claim 16

However, the PTO does not have the power to require an Applicant to cut up a single claim.

In view of the Examiner's statement at the end of the Official Action that Applicants may choose to prosecute method of use and pharmaceutical composition claims of a scope commensurate with the elected compounds in the same application with the elected compounds, the Examiner is respectfully urged to examine on their merits Claims 1 through 15, in which Applicants have claimed their invention as they choose, as is their right.

If the Examiner persists in his view that generic Claims 1, 6, 11, and 16 are improper Markush claims, he is respectfully requested to follow the examination procedure set out in the Commissioner's Notice of October 23, 1978 (976 OG 128), beginning with the provisionally elected claims.

Respectfully submitted,


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